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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,404	10/16/2001	Michiaki Yokoyama	1341.1112	3181
21171	7590	03/09/2006	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			MCALLISTER, STEVEN B	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/977,404

Applicant(s)

YOKOYAMA ET AL.

Examiner

Steven B. McAllister

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 10 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/5/2005 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5, 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 5 and 10 recite that "the information of the existing customer in the first file is transferred to the second file when orders are received from other terminals", however this is unclear. As understood by the examiner, the information from the first file of the existing customer is entered into the second file upon the customer's registration in the referral program.

As to claim 2, "and/or" is indefinite.

As to claim 11, the claim is unclear because it recites sending a "mail" via the terminals. In examining the claims, it was assumed this was meant to mean "email".

Also, claim 11 is indefinite because it recites that customers are stored based on "receipt of a response to the first mail or second mail". As understood by the examiner, a response to the first email would not affect any categorization of the potential customer, and a reply to the second email would not affect the categorization of the existing customer. Also, it is not clear who receives the response (is the potential customer categorized in a particular way if he responds to the existing customer, the existing customer being in receipt of the email?).

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-5, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mullaney in view of "Word of Mouth Takes Off" (hereinafter "Word").

As to claims 1 and 5, Mullaney shows transmitting to a first terminal of an existing customer a first email requesting an introduction of new customers, based on information on the customer, said information comprising at least his email address, in a first file; transmitting to a potential new customer a second email including information on the business, the person introduced becoming a new customer having his information registered to a third file when the person places an order; and transmitting a

third mail requesting an introduction of another new customer to the second terminal when the person is regarded as an existing customer based on the information in the third file; and wherein the information of the existing customer in the first file is transferred to the second file when orders are received from other terminals.

Mullaney does not explicitly show registering the information of the existing customer to a second file upon receiving an application as an introducer; or that the second email is sent to the first terminal to be transferred to a second terminal.

Word shows sending the second email to the first terminal, the existing customer forwarding it to the potential new customer at the second terminal. It would have been obvious to one of ordinary skill in the art to modify the method of Mullaney by forwarding the second email to the first terminal to be sent to the second terminal as taught by Word in order to increase the likelihood that the potential new customer will read the email, since it is sent from a friend.

As for copying the information of the existing customer to the second file, it would have been an obvious matter of design choice to do so since the specification does not disclose that the particular storage location of the information solves any particular problem or is for any specific reason, and it appears that the information storage would function equally well in either configuration.

Alternatively, as to claims 1 and 5, Mullaney shows transmitting to a first terminal of an existing customer a first email requesting an introduction of new customers, based on information on the customer, said information comprising at least his email address,

in a first file; transmitting to a potential new customer a second email including information on the business, the person introduced becoming a new customer having his information registered to a third file when the person places an order; and transmitting a third mail requesting an introduction of another new customer to the second terminal when the person is regarded as an existing customer based on the information in the third file; and wherein the information of the existing customer in the first file is transferred to the second file when orders are received from other terminals.

Mullaney does not explicitly show registering the information of the existing customer to a second file upon receiving an application as an introducer; or that the second email is sent to the first terminal to be transferred to a second terminal.

Word shows sending the second email to the first terminal, the existing customer forwarding it to the potential new customer at the second terminal. It would have been obvious to one of ordinary skill in the art to modify the method of Mullaney by forwarding the second email to the first terminal to be sent to the second terminal as taught by Word in order to increase the likelihood that the potential new customer will read the email, since it is sent from a friend.

As for copying the information of the existing customer to the second file, the examiner takes official notice that it would have been obvious to one of ordinary skill in the art to further modify the method of Mullaney as taught by Graham et al in order to better enable tracking of those registered in the referral program.

As to claim 6, it is noted that Mullaney in view of "Word" shows all recited functional units, the functional units accomplishing the steps of the method of claim 1.

As to claim 2, Mullaney in view of "Word" shows providing an incentive upon the new customer ordering a service or good.

As to claim 3, Mullaney in view of "Word" show that the email address is selected from an address book of the first terminal.

Alternatively, Mullaney in view of "Word" show all elements except that the email address is retrieved from an address book. However, the examiner takes official notice that to input an email address from an address book into an email is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to do so in order to reduce the chance of mis-typing the email address and to save time.

As to claim 4, Mullaney in view of "Word" do not show requiring the introduced person to provide information about the existing customer at the order step. However, the examiner takes official notice that it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to require the introduced person to provide information, such as a name or email address, of the existing customer in order to facilitate provide the incentive to the existing customer.

As to claim 10, it is noted that Mullaney in view of Word show all elements of the claim discussed above regarding claims 1 and 5, plus sending a plurality of emails to a plurality of different second terminals (see e.g., spaces for three referrals in Fig. 4).

As to claim 11, it is noted that Mullaney in view of Word and the well known prior art as applied above show all elements including categorically storing information of the existing customer and the potential customer based on receipt of responses.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

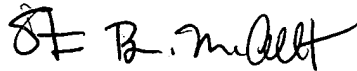
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (571) 272-6785. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander G. Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steven B. McAllister

Steven B. McAllister  
Primary Examiner  
Art Unit 3627

**STEVE B. MCALLISTER**  
**PRIMARY EXAMINER**